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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,608	08/22/2003	Yoshio Sugimoto	2895-0138P	8586

2292 7590 08/04/2006

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EXAMINER

THEXTON, MATTHEW

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 08/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/645,608		SUGIMOTO ET AL.	
	Examiner		Art Unit	
	Matthew A. Thexton		1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Text of Title 35 USC not Cited

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims Version

The claims as originally filed have been examined

Claim(s) Objection(s)

Claims 1 and 6 are objected to under 37 CFR 1.75(i) as being in improper form because each of a plurality of elements or steps of a/the claim(s) should be separated by a line indentation. See MPEP § 608.01(m). The elements of claim 1 requiring separate line indentation are (1), (2), (a), (b), and (c). The elements of claim 6 requiring separate line indentation are (b-1), (b-2), and (b-3).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6838510 in view of Baba et al. (JP 01-40566-A, also known as JP 64-40566-A, as evidenced by the USPTO obtained translation) and Malm et al. (US 6017989A).

The statement of rejection set forth in the Office action dated 2005 November 28 is incorporated here by reference. Note that the citation at line 3 of page 3 should be to "column 7 [not 4], lines 1-3."

Claim Rejections

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugimoto et al. (WO 02/094933, as evidenced by US 6838510B2) in view of Baba et al. (JP 01-40566-A, also known as JP 64-40566-A, as evidenced by the USPTO obtained translation) and Malm et al. (US 6017989A).

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a certified translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

The statement of rejection set forth in the Office action dated 2005 November 28 is incorporated here by reference. Note that the citation at line 15 of page 4 should be to "column 7 [not 4], lines 1-3."

Response to Arguments

Applicant's arguments filed 2006 May 30 have been fully considered but they are not persuasive.

At page 4, first full paragraph, Applicants assert there is no reason to modify '510 to employ aluminum flakes because it fails to suggest aluminum flakes. This is responded to as follows: It is true that '510 does not explicitly suggest using aluminum flakes, however this does not address the arguments of the rejections in which '566 and '989 are relied upon.

At page 4, second full paragraph, Applicants note that '566 was published prior to the filing date of '510 and concludes that because '510 didn't mention aluminum flakes such as those of '566 that such is evidence of non-obviousness. This is responded to as follows: Obvious modifications of a reference do not need to be suggested in that reference, such may arise from other sources, as in this instance references '566 and '989 have been relied upon.

At page 4, third full paragraph, Applicants refer to examples at pages 25-6 of the specification, noting that "highly desirable results" are attained which are "neither anticipated nor suggested by the prior art." This is responded to as follows: The only results that reflect upon the use of the coated aluminum flakes is example 1, which is compared to comparative example 1, and is stated to be visually free of agglomeration of aluminum flakes on the surface of the mold (bottom of page 24 to top of page 26). It would be expected that resin coated aluminum flakes are better dispersed in resin than uncoated ones because the hydrophobic character would be expected to permit better

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dispersion and thus less agglomeration in the resin matrix, as well as being less likely to adhere to the mold and thus less likely to agglomerate upon it. Assuming *arguendo* that the reduced agglomeration were unexpected, Applicants' showing, consisting of one specific mixture, is not reasonably commensurate in scope to the scope of the claims, comprising unbounded amounts of (2) coated aluminum flake, and broad ranges of amounts of (1), (a), (b), and (c).

At the bottom of page 4 and the first full paragraph of page 5, Applicants discuss '989. Applicants note that '989 does not suggest specially coated aluminum flake may be added to resin, nor then, that such would provide advantages. This is responded to as follows: This does not address the arguments of the rejections in which '989 is relied upon; the reference is relied upon for that which it does suggest, not for things it does not.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew A. Thexton whose telephone number is 571-272-1125. The examiner can normally be reached on Monday-Friday, 9:30 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasudevan S. Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. A. Thexton

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